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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/726,129   | 12/02/2003  | Donald E. Weder      | 8404.032            | 3545             |
| 30589  | 7590        | 05/25/2004           | EXAMINER            |                  |
| DUNLAP, CODDING & ROGERS P.C.<br>PO BOX 16370<br>OKLAHOMA CITY, OK 73113 |             |                      | HAYES, BRET C       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3644                |                  |
| DATE MAILED: 05/25/2004  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/726,129

Applicant(s)

WEDER, DONALD E.

Examiner

Bret C Hayes

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3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 1 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Specification*

1. The use of at least the trademark CLING WRAP has been noted in this application. Any trademarks should be capitalized wherever they appear and be accompanied by their generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

### *Claim Objections*

2. Claims 1 and 15 are objected to because of the following informalities: claim 1, line 8, and claim 15, line 11, it has been held that the functional “whereby” statement does not define any structure and accordingly cannot serve to distinguish, [*In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957)]; and claim 1, line 12, and claim 15, line 12, “a” before texture should be replaced with --the--. Since “a texture or appearance simulating the *\*[sic]* texture or appearance of cloth” has been previously recited, any further recitations of that “texture or appearance” should be preceded by a definite article, such as --the--. \*Examiner has rejected the claims due to this use of the definite article “the” as explain below. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1 – 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1 and 15 recite the limitation "the texture or appearance of cloth" in lines 8 and 10, respectively. There is insufficient antecedent basis for this limitation in the claims. The reason is that to reword this phrase would create "the cloth texture or appearance", which more clearly lacks antecedent basis.

6. Any unspecified claim is rejected as being dependent upon a rejected base claim.

***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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8. Claims 1 – 28 are rejected under the judicially created doctrine of double patenting over claims 1 – 58 of U. S. Patent No. 6,324,813 B1 to Weder, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an article and a method of use.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

9. Alternatively, claims 1 – 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 58 of U.S. Patent No. 6,324,813 B1 to Weder. Although the conflicting claims are not identical, they are not patentably distinct from each other because the article claims of this application do not distinguish over the method of use claims of the patent. In other words, one must have the article of claims 1 – 28 of this application, or the article would at least be obvious to one of ordinary skill in the art at the time the invention was made, in order to use the method of claims 1 – 58 of the patent.

*Claim Rejections - 35 USC § 102*

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 – 7, 12 – 21 and 26 – 28 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,413,725 to Bruno et al.

12. Re – claims 1 and 15, Bruno et al. disclose the claimed invention including – please substitute like terms, such as, “plant package” of claim 15 for “decorative cover” of claim 1, etc. – a decorative cover for a flower pot 18 having an outer peripheral surface (inherent to most flower pots) and containing a floral grouping 20, the cover comprising: a flexible sleeve 12 having an upper end (near the top of Figs. 1 – 3, for example), a lower end (near the bottom of Figs. 1 – 4, for example), an inner peripheral surface (inherent in most sleeves), an outer peripheral surface (again, inherent in most sleeves), an inner retaining space (again inherent in most sleeves, and best seen in Figs. 1 – 3, for example) for receiving the flower pot 18, and perforations 14, 16 at pre-selected areas, the sleeve 12 formed of a polymeric material, as set forth at col. 1, line 49, “polyethylene plastic”, having at least a portion of one surface thereof modified to provide a texture or appearance simulating a texture or appearance of cloth, see Fig. 6, for example, and the specification as set forth beginning at col. 2, line 29,

“a printed polyethylene plastic 30, [wherein]...[a]ny number of colors or different decorations can be used...and...will be completely visible through the clear plastic”

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(examiner asserts that a cloth-like texture or appearance would fall under the any number of colors and decorations disclosed), the sleeve 12 being positionable about the pot 18 such that when the pot 18 is disposed in the sleeve 12, a lower portion 24 of the sleeve 12 closely surrounds and encompasses the pot 18 and an upper portion 26 of the sleeve 12 extends upwardly from the pot 18 and substantially surrounds and encompasses the floral grouping 20 contained within the pot 18, the upper portion of the sleeve 12 being removable from the lower portion of the sleeve 12 along the perforations 14, 16, as set forth beginning at col. 2, line 10,

“After the potted plant reaches its destination, it is desirable to remove the upper portion 26 of the sleeve 12 in order to arrange the plant in an attractive manner. Accordingly, the upper portion 26 of the sleeve 12 is separated from the lower portion 24 of the sleeve to exhibit or display the flowers. The lower portion 24 of the sleeve 12 remains in position around the pot 18”, and, “As can be seen in FIG. 4, the lower portion of sleeve 12, which is of a transparent material, remains around the pot 18 to hold the decorative sheet 25 in position and in visual display.”

the sleeve 12 having a bonding material disposed upon a portion of at least one of the inner peripheral surface and the outer peripheral surface thereof 32, 33 for holding overlapping portions of the sleeve 12 in a crimped position adjacent the pot 18.

13. Re – claims 2 and 16, Bruno et al. further disclose the lower end 24 of the sleeve 12 being closed, as set forth beginning at col. 1, line 51.

14. Re – claims 3 and 17, Bruno et al. further disclose the perforations 14, 16 on the sleeve 12 being vertical and circumferential perforations.

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15. Re – claims 4 and 18, Bruno et al. do not disclose the sleeve 12 being provided with a thickness in a range of from about 0.1 mil to 30 mil, however, this range is inherent and well known in the plastic sheet art.

16. Re – claims 5 – 7 and 19 – 21, Bruno et al. further disclose two or more layers, as set forth beginning at col. 2, line 29, the layers being laminated, see same, and the sleeve 12 being provided with a printed pattern, see same.

17. Re – claims 26 – 28, Bruno et al. disclose the portions of the sleeve 12 having the texture or appearance of cloth as set forth above in paragraph 12.

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 8 – 11 and 22 – 25 are rejected under 35 U.S.C. § 103 as being unpatentable over Bruno et al. in view of US Patent No. 5,029,412 to Weder et al.

20. Bruno et al. disclose the invention substantially as claimed, except for embossing a pattern, and the pattern being either in or out of registry.

21. Weder et al. teach embossing a pattern, as set forth beginning at col. 3, line 53, in the same field of endeavor for the purpose of creating a decorative pattern.

22. It would have been obvious to one having ordinary skill in the art at the time the invention was made to emboss the pattern as taught by Weder et al. in order to create a



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decorative pattern. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the pattern be either in or out of registry, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

***Conclusion***

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan, can be reached at (703) 306 – 4159. The fax number is (703) 872 – 9306.

bh

5/18/04

*Charles T. Jordan*  
**CHARLES T. JORDAN**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**